



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,413	03/30/2004	Toyoji Ikezawa	116692005600	1276
25227 7590 10/20/2009 MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102				
EXAMINER SINGH, GURKANWALJIT				
ART UNIT 3624		PAPER NUMBER		
MAIL DATE 10/20/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/812,413

Applicant(s)

IKEZAWA, TOYOJI

Examiner

Gurkanwaljit Singh

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-14 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date 20090409
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This non-final Office action is in response to Applicant's communication received on July 20, 2009, wherein claims 1-7, and 9-14 are currently pending. Claims 8 and 15 have been cancelled. Claims 1, 4, 7, and 9-14 are currently pending.

Response to Arguments

2. Applicant's arguments filed July 20, 2009 have been fully considered but they are not persuasive.

3. Applicant argues that Melchione does not teach or suggest anything about a combination including a report that contains information on a customer of a sales negotiation item whose sales negotiation progress level is equal to or greater than a predetermined level. In response to Applicant's argument, Examiner respectfully disagrees. Examiner broadly interprets "report" to mean informing through any means information describing some type of findings (WordNet® 3.0, © 2006 by Princeton University at [dictionary.com < http://dictionary.reference.com/browse/report >](http://dictionary.reference.com/browse/report)). Examiner also broadly interprets "negotiation" to mean sales interaction with a customer about a product/service/etc. Melchione discloses a "micromarketing workstation" that, among other things, "generates a report containing an optimum list of leads (customers) for each marketing campaign." The micromarketing workstation of Melchione "allows the user to generate marketing information or leads and feed the leads directly into the CCIS...[a] plurality of micromarketing workstations may be used within the

micromarketing center to respond to requests from branch managers for lists of leads for selected sales programs...[t]he system provides the following features: a relationship profile that allows appropriate staff members to view household and customer account and balance information both in detail and summary form; account management features that allow bankers to enroll customers in programs such as portfolio management and personal relationship management; a relationship building feature that delivers prioritized call lists on-line and tracks results; a promotional suppression facility that provides information on customers and noncustomers who do not wish to be contacted by telephone and/or by mail; and a contact history feature that displays recent promotional contacts to each customer...a large financial institution... personal bankers then conduct sales sessions (e.g., telephone calls) with each of the customers on the list of leads (negotiations)" (col. 8, line 51 – col. 9, line 65, and col. 5, line 31 – col. 12, line 48). Melchione also discloses that "[a] performance (progress level) versus goals (which are predetermined levels) report indicates whether a particular branch or personal banker is meeting the goals (equal to or greater than) set by the campaign management" (col. 41, lines 51-53). Therefore, Melchione discloses a combination including a report that contains information on a customer of a sales negotiation item whose sales negotiation progress level is equal to or greater than a predetermined level.

4. Applicant also argues that Melchione does not disclose information on customers targeted by the customer targeting unit is automatically included in the evaluation report

of each salesperson. This limitation is newly added to the amended claims and is therefore addressed for the first time in the rejection below.

Examiner also notes that Melchione states that the system includes a central database that receives comprehensive information from a variety of internal and external feeds, and standardizes and households the information in a three-level hierarchy (households, customers, and accounts) for use by a financial institution; [t]he comprehensive information stored on the central database is accessed through micromarketing workstations to generate lists of sales leads for marketing campaigns; a database engine is provided for generating logical access paths for accessing data on the central database to increase speed and efficiency of the central database; and the system distributes sales leads electronically to branch networks, where the sales leads are used to target customers for marketing campaigns (Abstract). Melchione further states that the "system can be used to target customers and generate lists (a.k.a reports)... the system of the present invention is linked directly to on-line branch systems...[i]n this way, leads, preferably loaded by the micromarketing center can be automatically sent to the branches...provides micromarketing centers with the ability to generate lists...includes a graphical user interface that allows the regional micromarketing center to generate lists identifying various types of mailing addresses and linking to the on-line CCIS branch systems; this allows the original marketing center to direct leads to a specific campaign...[i]n general, the process flow may be described as follows: [i]nitially, branch users (bank management) decides on a sales promotion;[t]he sales promotion concept is communicated to the regional

micromarketing center;[t]he system allows the regional micromarketing center to use the user work station to generate leads;[l]eads are automatically loaded to a system for providing leads to the branch users and personal bankers overnight...[t]he central customer information system ("CCIS") preferably includes a relationship profile component, an account management component, a lead management system, or a sales tracking and reporting (management information system or "MIS") component; [e]ach component can generate reports, which are provided to the branch to complete the sales process" (col. 6, lines 52—col. 7, line 30). Therefore, Melchione indeed discloses that information on customers targeted by the customer targeting unit is automatically included in the evaluation report of each salesperson.

Claim Rejections - 35 USC § 101

5. **Claims 1-7, and 9-14** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
6. The methods recited in **claim 14** is rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter based on Supreme Court precedent, and recent Federal Circuit decisions, *In re Bilski U.S. Court of Appeals Federal Circuit 88 USPQ2d 1385*. The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either

branch. First, as illustrated by Benson and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See Flook, 437 U.S. at 590.

The methods recited in claim 14 are not tied to a machine nor transform the underlying subject matter to a different state or thing. See Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); and Gottschalk v. Benson, 409 U.S. 63, 71 (1972).

A method/process claim that fails to meet the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claim 14 fail to meet the above requirements because they are not tied to another statutory class of invention.

Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See Benson, 409 U.S. at 71-72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

3. **Claims 1-7, and 9-13** are drawn to a computer program per se. Computer programs per se intrinsically require no tangible physical structure, thus do not constitute tangible physical articles or other forms of matter. Therefore, computer programs per se are not considered to be statutory subject matter. To be statutory, a computer program must be: (1) coupled with or combined with some statutory physical structure, and, (2) produce or effect some useful, concrete, and tangible result.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 3, 4, 7, 9-11, and 13-14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 1, 3, 11, and 13-14 recite the term "sales negotiation item." However, neither the claims nor the specification explicitly discloses what a "sales negotiation item" is. To expedite prosecution, Examiner interprets "sales negotiation item" to mean an item (a product or good) for sale. Consequently, "sales negotiation item information" is interpreted as information regarding the item being negotiated.

10. Claims 1, 9-10, and 13-14 recite the terms "an evaluation report document sending unit" and/or "send[ing] the evaluation report document to customer terminal."

However, neither the claims nor the specification disclose how a "document" is "sent" to the customer terminal. "Sending" a "document" can just be a human action (e.g. by mailing, physically delivering the document, etc). Consequently, it is unclear what the applicant means by the term "document."

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1-7, and 9-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Melchione et al. (U.S. 5,930,764) in view of Solomon (US 2002/0046157).

13. As per claim 1, Melchione et al. discloses a sales activity management system comprising:

a database that stores activity management information concerning activity content of each salesperson and sales negotiation item information concerning each sales negotiation item that each salesperson is in charge of (col. 5, lines 32-35; col. 13, line 62-col. 14, line 6; col. 14, lines 48-54; The database is linked to a relationship profile component, an account management component, a lead management component and a sales tracking component.);

an activity content evaluation unit that evaluates the activity content of each salesperson based on at least one of the activity management information and the sales negotiation item information, registered in said database (col. 37, line 45-col. 38, line 25);

an evaluation report document creating unit that generates as evaluation report document including evaluation report information concerning the activity content of each salesperson, based on the evaluation results by said activity content evaluation unit (col. 37, lines 57-61);

a customer database that stores customer information concerning customers (col. 15, lines 57-63; Figure 3); and

a customer targeting unit that extracts sales negotiation item information wherein a sales negotiation progress level of the sales negotiation item is equal to or higher than a predetermined level ***among a plurality of sales negotiation items that are in progress by a sales person***, targets the customer of sales negotiation indicated by the extracted sales negotiation item information, extracts the customer information of the targeted customer from the customer database, and adds the customer information to said evaluation report information (col. 27, lines 33-48; Customer meeting a certain criteria may be selected via a database query, where the selected customers are targeted for specific marketing campaigns); and

an evaluation report document sending unit that sends the generated evaluation report document including the customer information added by the customer targeting unit and the evaluation report information, to a terminal device of the salesperson (col.

37, lines 54-57, col. 8, line 51 – col. 9, line 65, and col. 5, line 31 – col. 12, line 48, col. 6, lines 52—col. 7, line 30 ["system can be used to target customers and generate lists (a.k.a reports)... the system of the present invention is linked directly to on-line branch systems...[i]n this way, leads, preferable loaded by the micromarketing center can be automatically sent to the branches...provides micromarketing centers with the ability to generate lists...includes a graphical user interface that allows the regional micromarketing center to generate lists identifying various types of mailing addresses and linking to the on-line CCIS branch systems; this allows the original marketing center to direct leads to a specific campaign...[i]n general, the process flow may be described as follows: [i]nitially, branch users (bank management) decides on a sales promotion;[t]he sales promotion concept is communicated to the regional micromarketing center;[t]he system allows the regional micromarketing center to use the user work station to generate leads;[l]leads are automatically loaded to a system for providing leads to the branch users and personal bankers overnight...[t]he central customer information system ("CCIS") preferably includes a relationship profile component, an account management component, a lead management system, or a sales tracking and reporting (management information system or "MIS") component; [e]ach component can generate reports, which are provided to the branch to complete the sales process"]).

As shown above, Melchione discloses a customer targeting unit that extracts sales negotiation item information wherein a sales negotiation progress level of the

sales negotiation item is equal to or higher than a predetermined level. Melchione further defines that the “product” typically refers to items. However, Melchione does not explicitly disclose that the customer targeting unit extracts sales negotiation item information from among a plurality of sales negotiation items that are in progress by a sales person.

Solomon discloses intelligent negotiation agents (INAS) which are autonomous intelligent software agents that negotiate for the acquisition of products, services and bundles by adopting roles of buying, selling and brokering; And further discloses the customer targeting unit extracting sales negotiation item information from among a plurality of sales negotiation items that are in progress by a sales person (¶¶ 0024, 0031-0040, 0083, 0205).

Therefore, it would be obvious to one of ordinary skill in the art to include in the system/method of Melchione the customer targeting unit extracting sales negotiation item information from among a plurality of sales negotiation items that are in progress by a sales person as taught by Solomon since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

14. As per claim 2, Melchione et al. discloses the sales activity management system according to claim 1, wherein the activity management information includes one of, or a

plurality of data of, number of registered sales negotiations, number of customer calls made, hours of activity, number of agreements reached in sales negotiations, rate of agreements reached in sales negotiations, sales proceeds, and estimate proceeds (col. 37, line 65-col. 38, line 4; col. 40, lines 3-8; col. 41, lines 65-67; Sales activity such as active leads, outcome of sales attempts, information relating to closing sales leads and amount of revenue generated by each salesperson are tracked.).

15. As per claim 3, Melchione et al. discloses the sales activity management system according to claim 1, wherein the sales negotiation item information includes data of progress level of each sales negotiation item (col. 39, lines 45-48; col. 40, lines 53-58; The status of each sales lead is tracked.).

16. As per claim 4, Melchione et al. discloses the sales activity management system according to claim 1, further comprising an activity pattern analyzing unit that extracts sales management information from said database, and analyzes the activity pattern of the salesperson, using the extracted sales management information, wherein:

said evaluation report creating unit generates advice information towards the activity content of each salesperson based on the analysis by said activity pattern analyzing unit, and adds the generated advice information to the evaluation report information (col. 41, lines 17-19 and 35-53; col. 42, lines 52-65; Sales reports show performance versus goals, sales by number of accounts, sales by new and existing products as well as sales by time periods. Also, customer scoring and contact strategies provide advice to salespeople on what to market/sell to which customers.). While Melchione et al. discloses measuring and reporting performance versus goal

information, Melchione et al. does not expressly disclose that the sales management information that has a number or rate equal to or greater than a predetermined number of registered sales negotiations or a predetermined rate of registered sales negotiations. However, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP. 2106.

17. As per claim 5, Melchione et al. discloses the sales activity management system according to claim 4, wherein said advice information includes activity instruction information towards each salesperson (col. 42, lines 52-65; Customer scoring and contact strategies provide advice to salespeople on what to market/sell to which customers.).

18. As per claim 6, Melchione et al. discloses the sales activity management system according to claim 4, wherein said activity pattern analyzing unit extracts sales management information from said database and analyzes the activity pattern of the salesperson using the extracted sales management information (col. 41, lines 17-19 and 35-67; col. 42, lines 52-65; Sales reports show performance versus goals, sales by number of accounts, sales by new and existing products as well as sales by time

periods. The amount of revenue generated by each salesperson is also measured.). While Melchione et al. discloses measuring and reporting revenue generated by each salesperson, Melchione et al. does not expressly disclose wherein a sales proceed or an estimate proceed is greater than a predetermined amount. However, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP*, 2106.

19. As per claim 7, while Melchione et al. discloses measuring sales activity with which to rank for each sales person such as revenue generated by each sales person (col. 41, lines 65-67), Melchione et al. does not expressly disclose ranking the activity content of each salesperson. However, Examiner takes Official Notice that ranking the activity of a salesperson was old and well known at the time of the invention as such ranking provides salespeople with a prioritization of what activities to work on first as those activities may be more profitable, for example. Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Melchione et al. to rank the activity content of each salesperson as doing so provides

salespeople with a prioritization of what activities to work on first as those activities may be more profitable, thereby enhancing the sales process.

20. As per claim 9, Melchione et al. discloses the sales activity management system according to claim 1, further comprising a knowledge database that stores knowledge information concerning know-how and knowledge in sales activity, correlating it with customer information registered in the customer database, wherein said customer targeting unit extracts knowledge information relating to the targeted customer from the knowledge database and sends the information to said terminal device, when sending the evaluation report information to said terminal device (col. 42, lines 51-65; col. 43, lines 5-16).

21. As per claim 10, Melchione et al. discloses the sales activity management system according to claim 1, further comprising a knowledge database that stores sales support information including at least one data of various promotional material, sales activity record, and delivery achievement concerning apparatuses, for using in sales activity, correlating it with customer information registered in the customer database, wherein said customer targeting unit extracts sales support information relating to the targeted customer from the knowledge database and sends the information to said terminal device, when sending the evaluation report to said terminal device (col. 42, lines 51-65; col. 43, lines 5-16).

22. As per claim 11, Melchione et al. discloses the sales activity management system according to claim 1, which receives information concerning results of sales activity carried out based on said evaluation report information, from said terminal

device, and registers at least one of the activity management information and the sales negotiation item information, which are based on the received information, to said activity management information database (col. 41, lines 19-27).

23. As per claim 12, while Melchione et al. discloses the ability for managers to monitor the performance of sales people (col. 33, lines 60-67), Melchione et al. does not expressly disclose the sales activity management system according to claim 1, wherein said evaluation report information further includes data of comments input by a manager of said each salesperson. However, Examiner takes Official Notice that having managers maintain comments about their staff was old and well known at the time of the invention. Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Melchione et al. to include comments input by a manager of a salesperson because doing so helps to record managers' opinions/reviews about their sales people's performance, thereby enhancing the monitoring of the performance of sales people.

24. Claims 13-14 recite subject matter similar to that already rejected above. Therefore, claims 13-14 are rejected on the same basis as claims 1-3, 5, 8-11 above.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gurkanwaljit Singh whose telephone number is (571)270-5392. The examiner can normally be reached on Monday to Thursday 8am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on (571)272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. S./
Examiner, Art Unit 3624
October 8, 2009

/Bradley B Bayat/
Supervisory Patent Examiner, Art Unit 3624